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In the Supreme Court of the United States

OCTOBER TERM, 1956

No. 523

ALVA G. BLANCHARD, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the Patent Office examiner appears at pp. 1-3 of Appendix A of the Petition, and the opinion of the Board of Appeals at pp. 3-6 of Appendix A. The opinion of the District Court (Pet. App. A, pp. 7-9) is reported at 132 F. Supp. 744, and the opinion of the Court of Appeals (Pet. App. A, p. 10) is reported at 233 F. 2d 699.

JURISDICTION

The decision of the Court of Appeals was entered on May 31, 1956 (Pet. App. A, p. 10). By order of Mr. Justice Black, entered August 10, 1956, petitioner's

time for filing a petition for a writ of certiorari was extended to October 27, 1956. The petition for a writ of certiorari was filed on October 23, 1956. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether the courts below erred in refusing to order the issuance of a patent to petitioner on the ground of double patenting.

2. Whether the courts below erred in refusing a patent to petitioner on the ground that the claims in suit were met by the prior art.

STATUTES AND REGULATIONS

The pertinent statutes and regulations are set forth in Appendix D to the Petition.

STATEMENT

Petitioner brought this action in the District Court under 35 U.S.C. (1952 ed.) 145 (based upon former R. S. 4915) to obtain an order requiring the issuance to him of a patent containing claims 1, 2 and 3 of his application for patent No. 581,373, filed March 7, 1945. His claim was denied by the District Court on the basis of double patenting and of unpatentability in view of cited prior art (Pet. App. A, pp. 7-9), and this denial was affirmed by the Court of Appeals on the opinion of the District Court (Pet. App. A, p. 10). The pertinent facts as stipulated by the parties and found by both courts are somewhat technical and complicated, involving four related applications by petitioner and three related patents; but they may be summarized as follows:

On October 14, 1935, petitioner filed an application for a patent on a valve operating structure, No. 44,988,

upon which patent No. 2,233,395 was granted on March 4, 1941 (Pet. App. B, p. 1). Pending final action on that application, however, petitioner, on April 6, 1940, canceled all claims therein except claim 14, stating that "Applicant reserves the right to amend the cancelled claims and make them the subject matter of divisional applications" (Pet. App. B, p. 2). Accordingly, patent No. 2,233,395 was granted only with respect to claim 14 of application No. 44,988.

On May 28, 1938, petitioner filed another application, No. 210,585, upon which patent No. 2,199,611 was granted on May 7, 1940 (Pet. App. B, p. 1). The parties have stipulated (Pet. App. B, p. 2) that "As granted on May 7, 1940, plaintiff's patent No. 2,199,611 included claims expressing one of the species defined in generic claims 1, 2, and 3" of application No. 581,373, filed March 7, 1945, the claims involved in the instant proceeding.

On February 20, 1941, petitioner filed still another application, No. 379,822, which issued as patent No. 2,395,212 on February 19, 1946 (Pet. App. B, p. 1). On March 7, 1945, while this application No. 379,822 was still pending, petitioner filed the fourth application, No. 581,373, the application here involved (Pet. App. B, p. 2). Claims 8, 9 and 10 of the third application, No. 379,822, which were not included in patent No. 2,395,212, are in substance the same as claims 1, 2 and 3 of the fourth application, No. 581,373, the claims involved in the present suit (Pet. App. B, p. 2), and petitioner is entitled to the benefit of the effective filing date of application No. 379,822 with respect to claims 1, 2 and 3 (Pet. App. B, p. 2).

The Patent Office examiner denied petitioner a patent on claims 1, 2 and 3 of application No. 581,373 (the

present application) on the ground of double patenting, holding that under well settled principles the earlier specific claims in patent No. 2,199,611 barred the issuance of patents on later generic claims to the same subject matter—which, as stated above, has been stipulated to be the case here—unless the generic claims were pending at the time that the species claims issued (Pet. App. A, pp. 1-2). Petitioner contended that he had protected his right to a patent upon generic claims 1, 2 and 3 of application No. 581,373, by reason of a generic claim (claim 15) contained in his original application No. 44,988, filed in 1935, and which was said to be still pending (Pet. App. A, p. 1). The examiner rejected this contention on the ground that claim 15 was not to the same subject matter as claims 1, 2 and 3 of the present application (No. 581,373) (Pet. App. A, p. 1). The examiner also held that, regardless of subject matter, claim 15 was canceled on April 6, 1940, or prior to the date of May 7, 1940, upon which the specific claims in patent No. 2,199,611 issued (Pet. App. A, p. 2). Since application No. 379,822 (which contained claims 8, 9 and 10, corresponding to present generic claims 1, 2 and 3) was not filed until February 20, 1941, the examiner concluded that no generic claim was pending at the time of the issuance of the specific claims in patent No. 2,199,611 on May 7, 1940, and therefore that petitioner's present application (No. 581,373) was necessarily barred by the rule against double patenting (Pet. App. A, p. 2).

The Patent Office Board of Appeals affirmed the decision of the examiner, and petitioner brought suit in the District Court to compel issuance of the patent (Pet. App. A, pp. 3-5). The District Court, in an opin-

ion based upon extensive findings of fact and conclusions of law (J. A. 20-23), agreed with the Patent Office tribunals that the claims were barred under the rule against double patenting (Pet. App. A, pp. 7-9). The court found further (Pet. App. A, p. 9) that the claims were also barred as met by the prior art, basing this conclusion upon evidence of three patents: patent No. 683,021, issued in 1901; patent No. 458,794, issued in 1891; and patent No. 7,767, issued in 1877 (Pet. App. A, p. 7). The court held that it had authority to consider these references even though they were not cited in the Patent Office proceedings, and found that these patents "have elements which perform the functions of the elements in plaintiff's claims, and do preclude the issuance of patents on such claims". Upon petitioner's appeal, the Court of Appeals affirmed on the opinion of the District Court (Pet. App. A, p. 10).

ARGUMENT

The courts below, in refusing on two independent and equally valid grounds to require the issuance of a patent to petitioner, applied well settled rules of patent law to the particular facts of this particular case. These decisions are clearly correct and raise no issues of law, general or specific, warranting review by this Court.[1]

1. The rulings below properly held petitioner's claims invalid on the ground of double patenting. It is firmly established that no patent on an application with

[1] The Court has said that, absent a conflict between circuits, it will not grant a writ of certiorari in an "ordinary patent case" that does not involve "an important issue of general patent law * * *." *Keller* v. *Adams-Cambell Co.*, 264 U.S. 314, 319; *Lamb & Bowler Corp.* v. *Western Well Works*, 263 U.S. 387, 393; see *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U.S. 175, 178-179.

generic claims may issue subsequent to the grant of a patent on claims to one of the species included therein, unless the application with the generic claims was made prior to the issuance of the species patent. *Gold* v. *Gold*, 187 Fed. 273 (C.A. 2); *Kaplan* v. *Robertson*, 50 F. 2d 617 (D. Md.); *Union Typewriter Co.* v. *Smith*, 173 Fed. 288 (W. D. Pa.); 2 Walker, *Patents* (Deller's Ed. 1937) 1283. Since patent No. 2,199,611—which was issued on May 7, 1940, and concededly contained a species claim of the genus represented by present generic claims 1, 2 and 3—preceded the filing of application No. 379,822, from which the present claims are derived (see the Statement, *supra*, p. 3), the Patent Office tribunals and the District of Columbia courts correctly held petitioner's claims to be unpatentable. He attempts to avoid the thrust of the rule against double patenting by arguing that a generic claim corresponding to present claims 1, 2 and 3—claim 15 of application No. 44,988, filed October 14, 1935—was in fact pending at the time that specific patent No. 2,199,611 issued on May 7, 1940. The courts below, however, rejected this contention for two reasons, either one a sufficient basis for denying the claims, and each demonstrably correct.

a. In the first place, the courts found (J. A. 21) that claim 15 of original application No. 44,988 "is not the same in substance as generic claims 1, 2, and 3, in suit." This factual finding, reaffirming the conclusion of the Patent Office examiner and the Board of Appeals, is in itself dispositive of petitioner's claim. The record amply supports this holding (see, *e.g.*, Pet. App. A. pp. 1, 5; respondent's brief in the Court of Appeals, p. 9); and the two-court rule, coupled with the almost binding force of concurrent administrative and judicial

findings on technical patent matters,[2] effectively forecloses further review. See *Comstock* v. *Group of Investors,* 335 U.S. 211, 214, and cases there cited.

b. Moreover, whatever the content of claim 15, the courts properly concluded that this claim was canceled on April 6, 1940, shortly prior to the issuance of the specific claims in patent No. 2,199,611, dated May 7, 1940. The original application for the present generic claims 1, 2 and 3 (in substance, claims 8, 9 and 10 of No. 379,822) was not filed until February 20, 1941, and accordingly at the time the specific patent issued in May 1940, there was no generic claim pending. Petitioner argues that there was no such hiatus in the pendency of the generic claims because in canceling claim 15 he had reserved the right to amend the canceled claim and make it the subject matter of a divisional application. But Rule 44 of the Rules of Practice in the United States Patent Office (Pet. App. D, p. 5) expressly provided that "A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application." The courts below properly held that upon the cancellation of claim 15 its subject matter was disclosed but no longer claimed, and accordingly that it could not validly be reserved. Rule 44 is a long-

[2] The Court of Appeals has consistently emphasized the great weight which must be given to concurrent factual findings of the District Court and of the Patent Office on scientific problems, refusing to disturb such findings unless clearly wrong, and resolving all doubt in favor of the correctness of the administrative and judicial action. See, *e.g., Gilbert* v. *Marzall,* 182 F. 2d 389 (C.A. D.C.); *Hydraulic Press Corporation* v. *Coe,* 134 F. 2d 49 (C.A. D.C.); *Reed* v. *Coe,* 132 F. 2d 599 (C.A. D.C.); *Morrison* v. *Coe,* 127 F. 2d 737 (C.A. D.C.).

established part of Patent Office procedure, having come into effect in 1888 (*Ex parte Mullen and Mullen*, 1890 C.D. 9, 11), and was properly applied here. Moreover, the construction and application of such a special patent rule by the Patent Office and the District of Columbia courts plainly does not call for review by this Court.

2. The decisions below were equally sound in holding claims 1, 2 and 3 unpatentable because met by the prior art. Although the patents evidencing the prior are were not cited in the Patent Office proceedings, they were nevertheless "properly received in evidence and properly considered" by the District Court. *American Steel & Wire Co. of New Jersey* v. *Coe*, 105 F. 2d 17 (C.A. D.C.); cf. *Butterworth* v. *United States ex rel. Hoe*, 112 U.S. 50, 61, holding that a suit under former R. S. 4915 "* * * is not a technical appeal from the Patent Office * * * confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits." The determination of the District Court that the claims in suit are met by the prior art is supported by more than substantial evidence (see pp. 16-17 of respondent's brief in the Court of Appeals), and in our view is clearly correct. These findings were affirmed by the Court of Appeals, and "are not to be disturbed unless plainly without support." *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U.S. 175, 178; see also *supra*, pp. 6-7.

CONCLUSION

For the reasons stated above, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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